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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,675	10/31/2001	Thomas D. Hanan	K35A1023	5322

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EXAMINER

POPHAM, JEFFREY D

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,675

Applicant(s)

HANAN, THOMAS D.

Examiner

Jeffrey D. Popham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20050817</u> . | 6) <input type="checkbox"/> Other: _____ |

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Remarks

Claims 1-6 are pending.

Response to Arguments

1. Applicant's arguments filed 7/18/2005 have been fully considered but they are not persuasive.

Applicant argues that the flags of Mankefors that are created and stored in a range of addressable locations using the access key obtained from the server need to be searched for to be found, which is a difficult process. Mankefors does teach that searching for the flags is a very difficult task, but the portion cited by applicant refers to a malicious party attempting to access the flags. In paragraphs 42 and 43, however, Mankefors discloses how the system accesses the flags, by using characteristics of the disk drive, timestamps, and random number generation to obtain the location.

Applicant argues that Mankefors teaches away from applicant's invention by storing the flags within the operating system of the computer. Paragraph 39 of Mankefors discloses that the flags can be stored within the program itself, placed at a location on the hard drive which is "difficult" to find, or within the operating system. Nowhere in the claim does it disclose what applicant has referenced (in the background) that is suggested as being why Mankefors teaches away from the present application.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Makefors (U.S. Patent Application Publication 2002/0010863).

Regarding Claim 1,

Mankefors discloses in a computer system including a host computer, a disk drive host interface and a disk drive having a disk storage medium with a first range of disk drive host interface addressable locations, a method for installing a mailbox file associated with the disk storage medium, the installation method comprising the steps of:

Obtaining a disk drive access key from an access key server, the access key being generated by the access key server as a function of an identifying characteristic of the disk drive (Page 4, Paragraph 36; and Page 6, Paragraph 50);

Creating a mailbox file in the first range of addressable locations using the access key obtained from the access key server (Page 5, Paragraph 38); and

Notifying the disk drive of a location of the mailbox file in the first range of addressable locations, wherein the disk drive can perform a function characterized by contents of the mailbox file (Page 5, Paragraph 38).

Regarding Claim 4,

Mankefors discloses in a computer system including a host computer, a disk drive host interface and a disk drive having a disk controller, a method for accessing a mailbox file associated with a first range of disk drive host interface addressable locations, the method comprising the steps of:

Recognizing a command from a host operating system in reference to the mailbox file associated with the first range of disk drive host interface addressable locations (Page 5, Paragraphs 42 and 43); and

Responding to the command by performing within the disk controller an executable function characterized by the contents of the mailbox file (Page 5, Paragraph 43).

The disk controller, by definition, directs and controls reading from and writing to a computer's disk drive. This means that the disk controller will perform an executable function characterized by the contents of the mailbox file every time the mailbox file is accessed.

Regarding Claim 5,

Mankefors discloses that the first range of disk drive host interface addressable locations refers to a storage space allocated in at least one of a disk storage medium and a computer memory associated with the disk controller (Page 5, Paragraph 42).

Regarding Claim 6,

Mankefors discloses that the mailbox file contains encrypted information (Page 4, Paragraph 36; and Page 5, Paragraph 39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankefors in view of Vogt (U.S. Patent 6,681,304).

Regarding Claim 2,

Mankefors does not disclose that the function is used to access a second range of addressable locations that are not disk drive host interface addressable and that are contained on the disk storage medium.

Vogt, however, discloses that the function is used to access a second range of addressable locations that are not disk drive host interface addressable and that are contained on the disk storage medium

(Column 3, lines 33-42). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the hidden storage system of Vogt into the software protection system of Mankefors in order to only allow access to private information when an appropriate password (key) is entered, so as to hide this information from malicious users and programs.

Regarding Claim 3,

Mankefors discloses that the access key is required in order to run specific software (Page 5, Paragraph 38), but does not disclose that the access key is required for an application program to access the second range of addressable locations via the mailbox file.

Vogt, however, discloses that the access key is required for an application program to access the second range of addressable locations via the mailbox file (Column 3, lines 33-42). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the hidden storage system of Vogt into the software protection system of Mankefors in order to only allow access to private information when an appropriate password (key) is entered, so as to hide this information from malicious users and programs.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER